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09/841,150	04/24/2001	Richard Alan Dayan	RPS9 2001 0015	6065

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SAWYER LAW GROUP LLP  
PO BOX 51418  
PALO ALTO, CA 94303

EXAMINER

LEMMA, SAMSON B

ART UNIT PAPER NUMBER

2132

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/841,150

Applicant(s)

DAYAN ET AL.

Examiner

Samson B. Lemma

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## ***DETAILED ACTION***

1. The request filed August 22, 2005 for a request for continued examination (RCE) under 37 CFR 1.114 based on patent application 09/841150 is acceptable and an RCE has been established. Independent **claims 1 and 6** have been amended. Claims **1-14** are pending.

### ***Response to Arguments***

2. Applicant's argument filed on July 21, 2005 has been fully considered but they are not persuasive.

Applicants **amended** the independent claims **1 and 6**, and added a new limitation which was not part of the original claims. Applicant added the following limitation, "...utilizing a basic input output system (BIOS) for the computer system" **on the independent claim 1 and 6 and another limitation " a basic input output system (BIOS)" on independent claim 6.**

Applicant's argument has been considered one by one.

#### **Applicant's first argument is regarding claims 1-6.**

Applicant's argument is based on the amended claims and argued that the newly added limitation shown above which is added on the independent claims is not suggested/discussed by **the references** on the record, namely Applicants admitted prior art (**AAPA**) and **IBM Technical disclosure (Bulletin)**.

**Applicants wrote the following in support of his argument** "Although the Bulletin functions well for its intended purpose, the AAPA in view of the Bulletin fails to teach or suggest the method and computer system recited in claims 1 and 6, respectively. In particular, the AAPA in view of the Bulletin fails

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to teach or suggest allowing a password to be provided for each of the plurality of sub-partitions utilizing a BIOS for the computer system. If the Bulletin is combined with the AAPA, the combination might add a boot manager using the teachings of the Bulletin to the AAPA. The boot manager would be used to obtain the appropriate password for the partition. Because a boot manager is used, Applicant respectfully submits that booted code from the hardfile would be used to request a password and validate the password provided. In contrast, the method and system recited in claims 1 and 6 utilize the BIOS to obtain a password and determine whether the partition or sub-partition is accessible. **A separate boot manager that may query the user later in the boot process is not necessary.** Instead, the password is handled utilizing the BIOS. The AAPA in view of the Bulletin thus fail to teach or suggest the method and computer system recited in claims 1 and 6. Accordingly, Applicant respectfully submits that claims 1 and 6 are allowable over the cited references.”

Though applicant admitted that the Bulletin does describe the use of passwords for booting partitions or a plurality of partition. Applicants argued that the AAPA in view of the Bulletin fails to teach or suggest the method and computer system recited in claims 1 and 6, respectively.

**Examiner disagrees with this argument.**

Examiner would first of all points out that the amendment does not at all change the scope of the limitation of the previous independent claims 1 and 6. The added limitation does not change the scope of the limitation since the added limitation “**utilizing a basic input output system (BIOS) for the computer system**” was already part of the previous independent claims 1 and 6 and was fully addressed by the previous office action. (See for example at the end of the independent claims, claims 1 and 6 at the last line recites “utilize a corresponding sub-partition as a boot source”.

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Examiner asserts that the amended limitation as just a repetition of something which has already been there.

**Examiner also** would out that **AAPA** first discloses the following limitation in claim 1, for which the applicant didn't have any argument. "**Allowing a plurality of sub-partitions to be defined in the partition,** (Page 1, lines 8-9; figure 1, ref. Num "20" and ref. Num "22,24,26,28") **the plurality of sub-partitions corresponding to a plurality of boot sources**"(Page 1,lines 10; Page 2, lines 11-17) and

And **IBM Bulletin** discloses the following,

Adding a features to the **BootManager** such that when the desired bootable partition is selected, the user is prompted to enter **a password for that particular partition before booting commences. By doing this, individual partitions may be protected from unauthorized access.** (Paragraph 1, lines 12-15). **This does not mean that a** separate boot manager that may query the user later in the boot process is necessary. This only implies that the **BootManager** is used as sort of interface to prompt the user to enter a password for that particular partition. This kind of facility is also required in the applicant invention so that the user is prompted and the user provides the sub-partition password and be able to boot from the sub-partition.[See for instance claim 2]

Furthermore **IBM Bulletin** further discloses that this solution allows the children to be restricted from accessing and modifying or corrupting the parents programs or data.(Paragraph 1, lines 9-11)

The main argument by the applicant is following "the password is not provided to each plurality of sub-partition instead IBM Bulletin is providing password for each plurality of partition."

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Providing password for each plurality of partition as it is taught by the IBM Bulletin and duplicating the same process and partitioning the partition further in to the sub-partition and providing password for each sub-partition as it is disclosed on the claim is obvious for one of ordinary skill in the art as long as both are used for the same purpose. The IBM Bulletin and the applicant disclosure are used for similar purpose which is to **allow different users access to different portions of the computer system to ensure that portions of the computer system remain secure**. This purpose is disclosed on the applicant disclosure as mentioned below **“According to the system and method disclosed herein, the present invention provides a more secure set of boot sources for the computer system. The boot sources allow different users access to different portions of the computer system to ensure that portions of the computer system remain secure.”**[See page 3, line 21-page 4, line 2 of the disclosure]. Like wise applicant’s disclosure on page 3, line 4, discloses the following, **“It may be desirable for only certain individuals, such as the network administrator or, in a family's computer, an adult, to have access to these utilities.”**

On the other side the **IBM Bulletin** further discloses the same function as recited as follows **“that this solution allows the children to be restricted from accessing and modifying or corrupting the parents programs or data”**.(Paragraph 1, lines 9-11)

From at least one of the explanations provided above, It is undoubtedly clear that the application and the reference on the record in particular IBM Bulletin have similar purpose regarding the ultimate use of the password, and since providing a password for each plurality of partition is already disclosed then partitioning the partition further and providing a password for each plurality of sub-partition of the partition is obvious for one of ordinary skill in the art. It is

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obvious since it is just a repetition of the same process. If one can do the first step, then the second step is obvious for one of ordinary skill in the art.

**Likewise, the examiner would also point out that, If partitioning the boot source in to a plurality of partitioning and providing a password for each partition is already taught in the IBM Bulletin as explained on Paragraph 1, lines 12-15 and it is also obvious for one having ordinary skill to duplicate the same process and continue partitioning each partition further in to the plurality of sub-partition and providing a password for each sub-partition. Duplicating the same process for the same purpose is obvious for one of ordinary skill in the art. In other words, allowing a password to be provided for each plurality of partition as oppose to duplicating the same process by partitioning each partition further in to sub-partition and allowing a password to be provided for each plurality sub-partition as the criterion for allowing different users access to different portions of the computer system to ensure that portions of the computer system remain secure, is obvious for one of ordinary skill in the art.**

**Applicant's second argument is regarding the dependent claims 2-5 and 7-10.**

Applicants argued that since the independent claims 1 and 6 are patentable therefore all the claims dependent thereon are also in condition for allowance for the same reasons argued for the independent claims 1 and 6.

**In response to the above argument by the applicant, the examiner replay discussed for the independent claims 1 and 6 above is also valid towards this argument.**

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Therefore Examiner asserts that since the added limitation does not at all change the scope of the previous claims and since the combination of the reference discloses the claim limitation the rejection is maintained.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art (hereinafter referred to as **Admission**) in view of IBM technical disclosure Bulletin ,TDB-ACC-NO: NN9611103 (reference U) (hereinafter referred to as **IBM**)

5. **As per claim 1 and 6, Admission** discloses a method for providing a trusted boot source in a computer system,  
The computer system (Page 1,line 6; fig 1, ref. Num "10") including  
A partition (Page 1, lines 8-9; fig 1, ref. Num "20") and  
An operating system,(Page 1, line 4, fig 1, ref. Num "12")  
The partition being nonviewable from the operating system,(Page 1, line 14)  
The method comprising the steps of:



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- Allowing a plurality of sub-partitions to be defined in the partition, (Page 1, lines 8-9; figure 1, ref. Num "20" and ref. Num "22,24,26,28") the plurality of sub-partitions corresponding to a plurality of boot sources;(Page 1,lines 10; Page 2, lines 11-17) and

- Admission discloses that the computer system might have other boot devices which is not shown on submitted figure 1, and these boot devices might be accessed by a user only with a password. (Page 1, lines 11-13)

- Admission does not disclose expressly allowing a password to be provided for each of the plurality of sub-partitions, **utilizing a basic input output system (BIOS) for the computer system,** the password being required for a user to utilize a corresponding sub-partition as a boot source.

However, in the field of endeavor **IBM**, discloses

- Adding a features to the BootManager such that when the desired bootable partition is selected, the user is prompted to enter a password for that particular partition or sub-partition before booting commences.( Paragraph 1, lines 12-15)
- IBM further discloses that this solution allows the children to be restricted from accessing and modifying or corrupting the parents programs or data.(Paragraph 1, lines 9-11) (The submitted disclosure on page 3, line 4, mentioned this scenario)

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to add the features of requiring a particular password for accessing and utilizing the corresponding partiton as per teachings of IBM in to the method as taught by Admission, in order to provide a secure/trusted boot source and booting system.

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6. **As per claims 2 and 7**, the combination of Admission and IBM discloses the method of providing a trusted boot source as applied to claims 1 and 6 above.

Furthermore, IBM discloses the method further comprising the step of: (c) allowing a user to boot from a sub-partition of the plurality sub-partitions if the user provides the password for the sub-partition. (Paragraph 1, lines 12-15)

7. **As per claims 3 and 8**, the combination of Admission and IBM discloses the method of providing a trusted boot source as applied to claims 1 and 6 above.

Furthermore, Admission discloses the method wherein, the partition (figure 1, ref. Num "20") is stored in a hardfile (figure 1, ref. Num "30") in the computer system.(figure 1, ref. Num "10") (Page 1, lines 7-8; figure 1, ref. Num "10"; ref. Num "20", ref. Num "30")

8. **As per claims 4 and 9**, the combination of Admission and IBM discloses the method of providing a trusted boot source as applied to claims 3 and 8 above.

Furthermore, Admission discloses the method wherein an identity of each of the plurality of sub-partitions and the password for each sub-partition is stored in the hardfile.(figure 1, ref. Num "30") and

IBM discloses how each partition is accessed with its corresponding password,( Paragraph 1, lines 12-15) (the combinations of IBM and the admission meets the recitation of this limitation)

9. **As per claims 5 and 10**, the combination of Admission and IBM discloses the method of providing a trusted boot source as applied to claims 1 and 6 above.

Furthermore, Admission discloses the method wherein the partition is lockable from the operating system.(Page 1,lines14-15)

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10. **As per claims 11 and 14**, the combination of Admission and IBM discloses the method of providing a trusted boot source as applied to claims 1 and 6 above.

Furthermore, the combination of Admission and IBM discloses the method wherein the partition includes at least one additional sub-partition not requiring a password. **(See the argument provided for this particular claim above. That is providing a password for each sub-partition is obvious for one of ordinary skill in the art as explained for the independent claims 1 and 6. If providing the password is obvious for each sub-partition then not providing a password for at least one sub-partition is an arbitrary design choice. Elimination of an element and its function is nothing but a design choice. See In re Karlson, 153 USPQ184 (CCPA 1963).)**

11. **As per claims 12 and 13**, the combination of Admission and IBM discloses the method of providing a trusted boot source as applied to claims 1 and 6 above.

Furthermore, IBM discloses the method further comprising utilizing an additional password for the partition. [Paragraph 1, lines 12-15]

**(IBM Bulletin** discloses the following,

Adding a features to the **BootManager** such that when the desired bootable partition is selected, the user is prompted to enter a password for that particular partition before booting commences. By doing this, individual partitions may be protected from unauthorized access. (Paragraph 1, lines 12-15)

If providing a password for each partition is already known then duplicating the process and providing an additional password is an arbitrary design choice. Duplicating the same process for the same purpose is an arbitrary design choice. In other words, allowing a password to be provided for each plurality of partition as oppose to duplicating the same process by providing additional password as the criterion for allowing different users access to different portions of the computer system to ensure that portions of the computer system remain secure, is a matter of arbitrary design choice and does not

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patentably distinguishes the claimed inventions from the references on the record. See St. Regis Paper Co. v. Bemis Co., Inc., 193 USPQ 8 (7<sup>TH</sup> Cir. 1977)).

### **Conclusion**

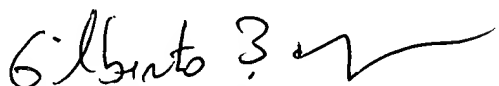
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samson B Lemma whose telephone number is 571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**SAMSON LEMMA**

11/09/2005

  
GILBERTO BARRON JR.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100